## REMARKS

Claims 47-50 are pending in the application and are at issue.

Claim 50 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, claim 50 stands rejected because of a typographical error that recites "$RO^8$" in the definition for substituent $R^7$. As suggested by the examiner, claim 50 has been amended to recite "$OR^8$." Support for this amendment can be found in the specification at page 14, line 13. Claim 49 also has been amended to correct a typographical error, and properly recite a Markush group.

In view of the amendment to claim 50, it is submitted that the rejection of claim 50 under 35 U.S.C. §112, second paragraph, has been overcome and should be withdrawn.

Claims 47-50 stand rejected under the judicially created doctrine of obviousness-type double patenting over claim 4 of Fowler et al. U.S. Patent No. 6,455,562 ('561), claim 17 of Fowler et al. U.S. Patent No. 6,294,561, and claim 25 of Martins et al. U.S. Patent No. 6,376,489 ('489). In view of the terminal disclaimer submitted concurrently with this amendment, and for the reasons set forth below, it is submitted that this rejection has been overcome with respect to the '489 patent and should be withdrawn with respect to the '562 and the '561 patents.

In particular, applicants submit a timely filed terminal disclaimer concurrently with this amendment. This terminal disclaimer overcomes the obvious-

ness-type double patenting rejection of claims 47-50 over claim 25 the '489 patent.

Applicants traverse the obviousness-type double patenting rejection with respect to the '562 and '561 patents. In particular, the examiner contends that $R^4$, $R^5$, $R^6$, and $R^{12}$ at the pyrrolidine 3-position of the presently claimed compound corresponds to $R^7$ of the '562 patent and the '561 patent, and that the present claims recite an $R^7$ that can be a tetrazole or oxatriazole. In view of the amendment to claim 50 that deletes the terms "heteroaryl" and "a heterocycle" from the definition of $R^7$, the obviousness-type double patenting rejection of claims 47-50 has been overcome. The generic structures in the '562 and '561 patents and the generic structure presently recited in claim 50 now are substantially different with respect to the 3-position of the pyrrolidine ring.

Accordingly, applicants respectfully submit that the claims of the present application now are patentably distinct over claim 4 of the '562 patent and claim 17 of the '561 patent. Further, applicants submit that in determining obviousness-type double patenting the question to be considered is stated in *In re Vogel and Vogel*, 164 U.S.P.Q. 619, 622 (CCPA 1970), i.e., "Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent?". The CCPA goes on to indicate that, "In considering the question, the patent disclosure may not be used as prior art."

As stated above, the present claims now are directed to a pyrrolidine 3-position substituent that is substantially different from the 3-position sub-

stituent of the '562 and '561 patents. The claims of the '562 and '561 patents do not teach or suggest the pyrrolidine 3-position substituent as presently recited.

In applying the test set out in *In re Vogel*, applicants submit that the present claims clearly are not made obvious to one of ordinary skill in the art by the claims of the '562 and '561 patents all directed to an *aromatic* substituent on the 3-position of the pyrrolidine ring. In particular, the present claims and the claims in '562 and '561 would be subjected to different searches because of the substantial differences between the substituents at the 3-position of the pyrrolidine ring.

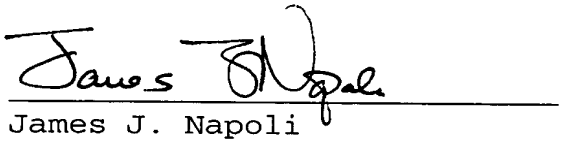
Furthermore, applicants clearly are not attempting to claim related subject matter in order to extend the patent term of the claims in the '562 and '561 patents which the doctrine of obviousness-type double patenting is intended to prevent. See, e.g., *In re Kaplan*, 229 U.S.P.Q. 278 (Fed. Cir. 1986). Accordingly, it is submitted that the rejection of claims 47-50 under obviousness-type double patenting over claim 4 of the '562 patent and claim 17 of the '561 patent should be withdrawn.

It is submitted that the claims are of proper form and scope for allowance. An early and favorable action on the merits is requested.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the examiner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

**MARSHALL, GERSTEIN & BORUN**

By 

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